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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,392	12/21/2000	Don C. McCall	S2646-00407USP3	3366

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EXAMINER

FUREMAN, JARED

ART UNIT	PAPER NUMBER
	2876

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/746,392	MCCALL ET AL
	Examiner	Art Unit
	Jared J. Fureman	2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 April 2003 .

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-7 and 26-42 is/are pending in the application.

4a) Of the above claim(s) 26-42 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-7 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 21 December 2000 is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) All b) Some \* c) None of:

        1. Certified copies of the priority documents have been received.

        2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .

        3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    \* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10 .

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt is acknowledged of the amendment filed on 1/21/2003, the power of attorney and amendment filed on 4/18/2003, all of which have been entered in the file. Claims 1-7 and 26-42 are pending.

#### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: --FUEL DISPENSING SYSTEM CREDITING A MONETARY VALUE IN A STORED RECORD TOWARD A PURCHASE OF FUEL--.

#### ***Election/Restrictions***

2. Newly submitted claims 26-42 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Group I. Claims 1-7, drawn to using a coded record to access a monetary value credited to a customer, and applying the monetary value to the customer's fuel purchase, classified in class 235, subclass 375.

Group II. Claims 26-42, drawn to providing a price per unit that is different than a posted price per unit to an identified customer, and providing a discount to an identified customer based upon the purchase of cross-marketed products or services, classified in class 705, subclass 14.

3. Inventions of groups I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for

patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the invention of group I may be used to access a monetary value credited to a customer without providing a different price per unit or a discounted price to the customer. The subcombination (group II) has separate utility such as providing a different price per unit or a discounted price without accessing a record storing a monetary value credited to the customer.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention (claims 1-7), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-42 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurowski et al (US 5,895,457, cited by applicant).

Kurowski et al teaches a system for dispensing fuel through a nozzle (28), comprising: a controller (26) in communication with the nozzle (via pump 22) for selectively causing the nozzle to dispense the fuel during a purchase by a user; a reader (voucher reader 40) connected to the controller for reading data provided by the user and transferring the data to the controller, a database (a balance information database, see column 6 lines 30-41) for storing a record corresponding to the data, said record including a monetary value credited to the customer (a balance); wherein upon receipt of the data, the controller is adapted to access the record, cause the nozzle to dispense the fuel, and credit the monetary value in the record toward the user's purchase of the fuel (the customer receives credit for the balance due); wherein the data is dependent upon past purchases made by the user (the balance due the user, from a previous fuel purchase, see column 6 lines 23-55); wherein the data comprises optical data (see column 6 lines 46-51); wherein the optical data comprises a bar code included on a receipt provided to the user during a past purchase (see column 4 lines 57-63 and column 6 lines 46-51); wherein the data comprises magnetic data (see

column 4 lines 57-63 and column 6 lines 46-51); wherein the magnetic data comprises a magnetic strip included on a card (the magnetic coding on a receipt/voucher, see column 4 lines 57-63 and column 6 lines 46-51), said magnetic data including a user identification associated with the user (the magnetic data includes a balance code that is associated with the user, since the balance code refers to the balance owed to the user), said user identification pointing the controller to the monetary value in the record credited to the user (see figures 1-3, 5, column 1 lines 9-14, 49-59, column 2 line 46 - column 3 line 11, column 4 lines 9-33, column 4 line 49 - column 5 line 7, column 5 line 51 - column 6 line 6, column 6 line 18 - column 7 line 46, and column 8 lines 33-41).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurowski et al in view of Greer et al (EP 0 511 463 A2, cited by applicant).

The teachings of Kurowski et al have been discussed above.

Kurowski et al fails to specifically teach the past purchases made by the user including the purchase of at least one cross-marketed product or service.

Greer et al teaches a method and apparatus including recording (in a discount certificate list) the purchase of cross-marketed products (triggering items) by a user (see

figure 1, column 2 line 28 - column 3 line 5, column 3 lines 26-47, column 7 lines 1-37, column 8 lines 22-36, and column 9 lines 29-45).

In view of Greer et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Kurowski et al, the past purchases made by the user including the purchase of at least one cross-marketed product or service, in order to encourage the user to purchase other products.

#### ***Response to Arguments***

10. The title suggested by applicants is acknowledged (see page 8 of the amendment filed on 4/18/2003). However, the title is directed to an invention (claims 26-42), which is independent of the originally claimed invention (claims 1-7). Since claims 1-7 have been elected by original presentation and claims 26-42 have been withdrawn from consideration as being directed to a non-elected invention, applicants suggested title is not approved. The examiner has suggested another title above.

11. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

As discussed above, Kurowski et al teaches a system that stores a credit value for a customer and credits the stored value to a fuel purchase, and Greer et al teaches storing a record including the purchase of a cross-marketed product.

12. Applicant's arguments with respect to claims 26-42 have been considered but are moot, since claims 26-42 have been withdrawn from consideration as being directed to a non-elected invention.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

July 14, 2003

*Jared J. Fureman*  
Jared J. Fureman  
Art Unit 2876